

REMARKS/ARGUMENTS

Claims 1-13 were pending. In the present response, Applicants have not amended any claims, leaving claims 1-13 pending in the present application for the Examiner's consideration. No new matter has been added.

In summary of the Office Action of May 5, 2005, the Examiner has:

I. Rejected Claims 1-3 and 6-13 under 35 U.S.C. § 103(a) as being unpatentable over MacPhail (U.S. Patent No. 5,179,718) in view of Khan (U.S. Patent No. 6,401,206); and

II. Rejected Claims 4-5 under 35 U.S.C. § 103(a) as being unpatentable over MacPhail in view of Khan and further in view of IBM "Technical Disclosure Bulletin".

Applicants respectfully traverse the Examiner's rejections.

I. Rejection of Claims 1-3 and 6-13 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-3 and 6-13 as unpatentable over as being unpatentable over MacPhail (U.S. Patent No. 5,179,718) in view of Khan (U.S. Patent No. 6,401,206). Claim 1 recites in part:

cryptographically securing the combination of the pages of at least two electronic documents of staple data object in response to receipt of the staple instruction, thereby creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time. (Emphasis Added)

Claim 9 recites a similar element. The Applicants respectfully submit that neither MacPhail nor Khan disclose or suggest this element.

The Examiner agrees that MacPhail does not teach the use of cryptography. (p.4, Office Action of 11/29/2005). Moreover, the Applicants respectfully submit that Khan fails to disclose or suggest the use of cryptography for "securing the combination of pages of at least two electronic documents," as recited by claim 1.

The Examiner cites the Abstract of Khan and Col. 11, lines 23-34, as teaching the use of cryptography. The cited portion of the abstract of Khan states "Document and digital identity verification including a verifying a cryptographic digital signature that establishes the integrity of the document." Similarly, column 11, lines 23-34 describe a process of "carry[ing] the electronic impressions, made by a digital identity on a given document, with the document itself using the conventional cryptographic systems."

In both cited portions, Khan clearly discloses that a single digital signature is used to protect the integrity of a single document. Khan does not disclose that a single digital signature can protect the integrity of the association of multiple documents. Thus, neither MacPhail nor Khan disclose "cryptographically securing the combination of the pages of at least two electronic documents" as recited by claim 1.

In response to the Applicants' previous remarks, the Examiner argues that MacPhail, which "teaches securing a staple object, 'creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time,'" may be combined with Khan "to teach the use of cryptography." (p.9, Office Action of 11/29/2005).

MPEP 2143.01 states that "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." (MPEP 2100-130).

The Applicants respectfully submit that there is no suggestion or motivation in the art to combine or modify the references to meet at least the above-recited claim limitation of "cryptographically securing the combination of the pages of at least two electronic documents ... thereby creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time," as recited by claim 1.

Khan discloses the use of cryptography for "verifying a cryptographic digital signature that establishes the integrity of a document." (Khan, Abstract). As discussed above, Khan discloses using cryptography only for protecting the integrity of a single document. Khan does not disclose or suggest associating multiple documents together for any purpose, let alone

applying cryptography to create "an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time."

In the case of MacPhail, there is nothing in MacPhail that discloses or suggests using cryptography or any other means to provide "an unalterable indicator of the existence and integrity of the association" of documents. To the contrary, MacPhail allows staple relationships to be freely modified or deleted without leaving any evidence.

According to MacPhail, "the staplee parameters are preserved within the document until the document is deleted from a document library or the document is unstapled by its last document." (MacPhail, Col. 6, lines 10-13) (Emphasis Added). "The history option . . . is deleted when the document is unstapled by another document and created when the document is stapled by another document." (MacPhail, Col. 6, lines 15-19) (Emphasis Added).

Thus, users of MacPhail can freely delete documents from a staple relationship without leaving any evidence that the staple relationship previously existed. This contravenes explicit language of the claims, which recite "creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time." (Emphasis Added).

MacPhail does not provide any suggestion or motivation for preserving or protecting the integrity of a staple relationship. Khan does not provide any suggestion or motivation for associating multiple documents together for any purpose. Thus, there is no motivation in the art to combine MacPhail and Khan.

Because neither MacPhail nor Khan disclose or suggest cryptographically securing the combination of electronic documents, "thereby creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time," Applicants respectfully submit that claims 1 and 9, as well as their respective dependent claims, are patentable over the cited references.

II. Rejection of Claims 4-5 under 35 U.S.C. § 103(a)

The Examiner has rejected claim 4 and 5 as unpatentable over MacPhail and Khan in view of "IBM Technical Disclosure Bulletin." As discussed above, neither MacPhail nor Khan

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disclose or suggest cryptographically securing the combination of electronic documents, "thereby creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time," as recited by claim 1. Similarly, there is nothing in "IBM Technical Disclosure Bulletin" that discloses or suggests any need or means for protecting document integrity. Applicants therefore respectfully submit that claims 4 and 5 are patentable for this reason as well.

CONCLUSION

In view of the foregoing, Applicant believe all claims now pending in this Application are patentable and in condition for allowance and respectfully request an action to that end.

The Applicant invite the Examiner to contact the undersigned if he believes a telephone conference would expedite the prosecution of this application.

Respectfully submitted,



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